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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,116	06/01/2001	Darrel D. Cherry	10008154-1	5580

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

BLACKWELL, JAMES H

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,116

Applicant(s)

CHERRY ET AL.

Examiner

James H Blackwell

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4, 9-10, 12, 14-15, and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith (U.S. Patent No. 5,860,362).

In regard to independent Claim 1, Smith teaches in Fig. 2, an electronic controller (34) is used to run the machine. In order for the vending machine to print out up to the minute information, the electronic controller (34) has an on-line connection (36) to a news providing organization (38). The on-line connection (36) may use the Public Switched Telephone Network (PSTN) with there being a modem (not shown) to provide the interface between the PSTN and the controller (34). The controller (34) contains a PC processor (40) to provide the control, a ROM (42) and a RAM (44) for storing the information received from the news providing organization (38). The PC processor (40) communicates with the keyboard (8) and a checking mechanism (not shown) associated with the payment slots (10) via a self-service Input/Output (I/O) system (54). The processor (40) communicates with the display (6) via a display subsystem (56). Also, the processor (40) communicates with the paper sensor (30), the printer (12), the bunching mechanism (22), the feeders (18a,18b) and a loudspeaker (48) and receives

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on-line information from the news providing organization (38) via a PC I/O System (58) (Col. 2, lines 43-63; compare with Claim 1, ***"A personalized media service device for producing media on demand, comprising a media selection interface for receiving a media request from a user and printing a hardcopy of said media request"***).

In regard to dependent Claim 2, Smith teaches that the controller (34) contains a PC processor (40) to provide the control, a ROM (42) and a RAM (44) for storing the information received from the news providing organization (38) (Col. 2, lines 51-54; compare with Claim 2, ***"... a memory for storing media data"***). Smith also teaches a printer (12) that prints the whole newspaper or the part of the newspaper requested. The printed sheet or sheets are taken by a feeder (18b) (Fig. 2) to an opening (20) in the housing (4) for collection by the customer (Col. 2, lines 24-28; compare with Claim 2, ***"... a printer device for printing said hardcopy of said media request"***). Smith also teaches that the controller (34) sends instructions to be displayed on the display (6). The loudspeaker (48) can be used to give verbal instruction in conjunction with the displayed instructions. The customer communicates his response back via a keyboard (8). The customer indicates what news he wants and the controller (34) displays on the display (6) the cost. The customer makes his payment via the payment slots (10) (Col. 3, lines 6-13; compare with Claim 2, ***"... an input device for retrieving information from a user"*** and ***"... a display device for displaying lists of available media selections and input options"***). Smith also teaches that the electronic controller (34) has an on-line connection (36) to a news providing organization (38). The on-line connection (36) may use the Public Switched Telephone Network (PSTN) with there

being a modem (not shown) to provide the interface between the PSTN and the controller (34) (Col. 2, lines 45-49; compare with Claim 2, “... **at least one communications port for communicating with a remote device**”). Smith also teaches that the controller (34) contains a PC processor (40) to provide the control (Col. 2, lines 51-52; compare with Claim 2, “... **a central processing unit for communicating with said memory, said printer device, said input device, said display device, and said at least one communications port**”).

In regard to dependent Claim 4, Smith teaches that the electronic controller (34) has an on-line connection (36) to a news providing organization (38). The on-line connection (36) may use the Public Switched Telephone Network (PSTN) with there being a modem (not shown) to provide the interface between the PSTN and the controller (34) (Col. 2, lines 45-49; compare with Claim 4, “... **a service provider for communicating with said central processing unit through said at least one communications port for receiving said information from a user and providing media in a data format to said media selection interface**”).

In regard to dependent Claim 9, Smith teaches that a card inserted into the card reader (52) may be of a type similar to a phone card which is purchased elsewhere and has a fixed number of units, initially stored on it. As purchases are made, the units stored on the card are reduced. If the card is of a type that needs connection to a banking system, this can be done via a modem connected to the PSTN. Connection to the PSTN allows access to the Internet. The self-service vending machine (2) can have the facility for credit card transactions to be transacted over the Internet (Col. 3, lines

23-32). Hence, transactions with the card would necessarily be authenticated before actions took place. Compare with Claim 9, “... ***an authentication device for communicating with said central processing unit for identifying a user of said personalized media service***”).

In regard to independent Claim 10, Smith teaches a system which comprises a self-service newspaper vending machine (2) includes an electronic control means (34) with an on-line connection (36) to a news providing organization (38) from which a newspaper containing up to the minute news can be purchased. A customer is attracted by news stories shown on a display (6). The customer is then given the opportunity of purchasing a newspaper or part of a newspaper. Communication between the customer and the vending machine (2) is by the display (6) and a keyboard (8). The newspaper can be purchased by either inserting a banking or credit card in a card reader (52) or inserting coins into a coin slot (50). The vending machine (2) would then print out the up to the minute news requested (see Abstract; compare with Claim 10, “***A method of creating a hardcopy media selection for a user, comprising: providing the user a menu of available media selections for choosing a desired media selection for creation; identifying a media selection made by the user; retrieving a data format copy of said media selection; and printing a hardcopy of said media selection from said data format copy of said media selection***”).

In regard to dependent Claim 12, Claim 12 reflects the method of creating a hardcopy media selection for a user as claimed in Claim 10, and is rejected along the same rationale.

In regard to independent Claim 14, Claim 14 reflects the method of creating a hardcopy media selection for a user as claimed in Claims 1 and 2 respectively, and are rejected along the same rationale.

In regard to dependent Claim 15, Smith teaches a printer (12) that prints the whole newspaper or the part of the newspaper requested. The printed sheet or sheets are taken by a feeder (18b) (Fig. 2) to an opening (20) in the housing (4) for collection by the customer (Col. 2, lines 24-28; compare with Claim 15, “... ***printing a hardcopy of said electronic copy of media associated with said media request on said printer device of said media selection interface***”).

In regard to dependent Claim 17, Smith teaches displaying the relevant cost; checking and accepting any payment made; printing the indicated at least one news item; and delivering the at least one printed news item to a customer (Col. 1, lines 57-60; compare with Claim 17, “... ***displaying the total cost of said media request on said display device of said media selection interface; prompting said user to make a payment for said media request; and verifying payment of said payment for said media request before communicating said media request to said service provider***”).

In regard to dependent Claim 18, Claim 18 reflects the method of creating a hardcopy media selection for a user as claimed in Claim 9, and is rejected along the same rationale.

In regard to dependent Claim 19, Smith teaches that the newspaper can be purchased by either inserting a banking or credit card in a card reader (52) or inserting coins into a

coin slot (50). The vending machine (2) would then print out the up to the minute news requested (see Abstract; compare with Claim 19, "... ***debiting a user's account for the cost of said media request following said printing of said hardcopy of said media request***").

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 7-8, 13, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Nozue et al. (hereinafter Nozue, U.S. Patent No. 5,845,262).

In regard to dependent Claim 3, Smith fails to specifically teach *media stored in a data format in said memory for retrieval by said central processing unit and printing by said printer device*. However, Nozue teaches that data formats of the electronic press information have to be unified for the whole system. Even if the electronic press information from the electronic press information producer (20) is not unified, it is sufficient to convert the format by the recording and editing system (34) of the center (32). However, costs are needed for edition. On the other hand, when the electronic press information is sold by the vending machines (40), it is necessary that a plurality of

press information can be used by the same portable terminal. The unity of the data formats is indispensable. As a unified format, for example, it is considered to use an MMR. The MMR is a format which is used even in a facsimile or the like because of the reasons such that data can be generally easily formed and complicated hardware and software are unnecessary in the consuming system, a compression ratio is high, and the like (Col. 9, lines 36-59; compare with Claim 3, “... **media stored in a data format in said memory for retrieval by said central processing unit and printing by said printer device**”). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Smith and Nozue, providing the benefit of a common format for the storage and retrieval of newspapers.

In regard to dependent Claims 7 and 8, Smith fails to specifically teach *at least one content provider in communication with said service provider for providing media in said data format to said service provider in response to said retrieved information and said at least one content provider comprises a media publisher computer for storing and transmitting said media in said data format to said service provider*. However, Nozue teaches that the producing system (1) is constructed by a publisher (10) and an electronic press information producer (20). Further, the publisher (10) is divided into a newspaper company (11), a publishing company (13), and a small-scale publishing company (15) (Col. 5, lines 45-49; compare with Claim 7, “... **at least one content provider in communication with said service provider for providing media in said data format to said service provider in response to said retrieved information**” and Claim 8, “... **said at least one content provider comprises a media publisher**”).

computer for storing and transmitting said media in said data format to said service provider"). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Smith and Nozue, providing the benefit of electronic sources of newspapers.

In regard to dependent Claim 13, Smith does not specifically teach *establishing a connection between a computer and a service provider using the Internet; linking said computer to a menu page stored in a memory of said service provider; retrieving a list of available media selections from said memory of said service provider; displaying said list of available media selections on said menu page linked to said computer; and prompting said user to choose one of said available media selections*. However, Nozue teaches that to receive electronic press information in a general home, the consumer makes a contract with the electronic press information distribution and sales trader and prepares a receiving terminal, thereby recording the electronic press information of newspaper, magazine, advertisement, town information paper, or the like which are distributed and transmitted twice a day toward the vending machine to the recording medium 52 (magneto-optic disk, IC memory, or the like), and the consumer can also use the information by a portable display terminal or a television, personal computer, or the like put in a home (Col. 22, lines 32-42). Comparing Figs. 1 and 13 show a similarity between the functions and methods of the vending machine and the in-home devices. Compare with Claim 13, "***... establishing a connection between a computer and a service provider using the Internet; linking said computer to a menu page stored in a memory of said service provider; retrieving a list of***

available media selections from said memory of said service provider; displaying said list of available media selections on said menu page linked to said computer; and prompting said user to choose one of said available media selections"). It

would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Smith and Nozue, providing the benefit of Internet access to electronic newspapers.

In regard to dependent Claim 16, Smith's teachings are limited to newspaper distribution via vending machine. However, Nozue teaches a system for mainly transferring various information of a newspaper, a magazine, an advertisement, and the like by dot data is provided. Data information provided from a newspaper company, publishing companies, and the like is converted into electronic press information via an electronic press producer (20). The electronic press information is dispatched from a center to an information vending machine through a satellite line or a terrestrial line. Dispatched press data is once accumulated to a recording unit in the information vending machine. When it is identified that an information fee has been paid by cash or a prepaid card, desired data in the information accumulated in the recording unit is written into a recording medium such as an IC card or the like of a consumer (16) (see Abstract; compare with Claim 16, ***"... retrieving a list of newspapers available to said media selection interface from said service provider; and retrieving a list of magazines available to said media selection interface from said service provider"***). It would have been obvious to one of ordinary skill in the art at the time of

invention to combine the teachings of Smith and Nozue, providing the benefit of access to a variety of media from a vending machine.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Dasan (U.S. Patent No. 5,761,662).

In regard to dependent Claim 5, Smith fails to teach *a computer for communicating with said central processing unit; at least one user profile database for storing demographic information about users of said personalized media service device received from said central processing unit; and at least one database of available media selections and corresponding media selection retrieval information for providing media in said data format to said central processing unit.* However, Dasan teaches that in order to control the parameters of the execution of this server-resident process, the client may direct the filling out of certain "forms" from his browser. This is also provided by the "fill-in forms" functionality (230) available under Mosaic version 2.0 and greater, which allows the user via his client application program (100), to specify a "profile" in which the server will cause an application program to function (e.g. the types of stories/articles which are of interest to the user) (Col. 4, lines 42-49). In addition, Dasan teaches that Fig. 4 illustrates the interaction between the server (150) and newspaper generator application program (400), which is operative under control of the CGI in the server. Depending upon user input, requests are sent to the active application in the server, in this case the personal newspaper generator (400), which causes the application to perform certain functions. For example, in the case of a profile that does

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not already exist in the server, newspaper generator (400) allows the creation and editing of search specifications, known as a "profile", on the server. This allows the server to generate the personal newspaper for the client when requested, or at regular intervals, according to implementation (Col. 5, lines 53-64). Compare with Claim 5, **"... a computer for communicating with said central processing unit; at least one user profile database for storing demographic information about users of said personalized media service device received from said central processing unit; and at least one database of available media selections and corresponding media selection retrieval information for providing media in said data format to said central processing unit"**). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Smith and Dasan, providing the benefit of a user profile to assist in determining the correct subject matter for the user of a vending machine.

In regard to dependent Claim 6, Smith fails to teach *said stored demographic information about a user in said user profile database is information selected from the group consisting of gender, age hobbies, interests, income, profession, education, marital status, vehicles owned, sports played, consumer goods owned, services used, and user preferences*. However, Dasan teaches selecting various user preferences (see Figs. 7, and 8; compare with Claim 6, **"... said stored demographic information about a user in said user profile database is information selected from the group consisting of gender, age hobbies, interests, income, profession, education, marital status, vehicles owned, sports played, consumer goods owned, services**

used, and user preferences”). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Smith and Dasan, providing the benefit of identifying how the user would like to see their media presented and organized.

In regard to dependent Claim 20, Smith fails to teach *retrieving a set of user preferences corresponding to said user identity from a user profile database; querying said determined content provider for said electronic copy of media associated with said media request; including said set of user preferences with said query; and creating a customized electronic copy of media associated with said media request based upon said set of user preferences*. However, Dasan teaches an automatic method and system for retrieving information based on a user-defined profile (e.g. a personalized newspaper). A user-controlled client establishes communication with a stateless server, the server presenting a list of options to the client (e.g. via Hypertext Transfer Protocol (HTTP) exchanges) between the server and the client. The client provides an identification of the user-defined profile. The server engages a first application program (e.g. via a Common Gateway Interface (CGI)), the first application program retrieving the user-defined profile wherein the user-defined profile identifies information that is of interest to the user. The first application program examines a database of information and automatically retrieves a subset of the information from the database based upon which information is of interest to the user as specified in the user-defined profile. The server presents the subset of the information from the database as generated by the first application program to the client (Col. 2, lines 1-20). It would have been obvious to

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one of ordinary skill in the art at the time of invention to combine the teachings of Smith and Dasan, providing the benefit of customized media available from a vending machine.

In regard to dependent Claim 21, Smith fails to teach *displaying a user log-in request on said display device of said media selection interface; prompting said user to enter log-in information using said input device of said media selection interface; communicating said log-in information to said service provider using said at least one communications port; comparing said log-in information to at least one user profile database accessible to said service provider to determine an identity of said user; authorizing use of the media selection interface when said identity of said user is determined; and prompting said user to register a user profile in said user profile database if said identity of said user is not determined and authorizing use of the media selection interface following completion of said registration of said user profile.*

However, Dasan teaches that in order to control the parameters of the execution of this server-resident process, the client may direct the filling out of certain "forms" from his browser. This is also provided by the "fill-in forms" functionality (230) available under Mosaic version 2.0 and greater, which allows the user via his client application program (100), to specify a "profile" in which the server will cause an application program to function (e.g. the types of stories/articles which are of interest to the user) (Col. 4, lines 42-49). In addition, Dasan teaches that Fig. 4 illustrates the interaction between the server (150) and newspaper generator application program (400), which is operative under control of the CGI in the server. Depending upon user input, requests are sent to

the active application in the server, in this case the personal newspaper generator (400), which causes the application to perform certain functions. For example, in the case of a profile that does not already exist in the server, newspaper generator (400) allows the creation and editing of search specifications, known as a "profile", on the server. This allows the server to generate the personal newspaper for the client when requested, or at regular intervals, according to implementation (Col. 5, lines 53-64).

Compare with Claim 21, ***"... displaying a user log-in request on said display device of said media selection interface; prompting said user to enter log-in information using said input device of said media selection interface; communicating said log-in information to said service provider using said at least one communications port; comparing said log-in information to at least one user profile database accessible to said service provider to determine an identity of said user; authorizing use of the media selection interface when said identity of said user is determined; and prompting said user to register a user profile in said user profile database if said identity of said user is not determined and authorizing use of the media selection interface following completion of said registration of said user profile"***). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Smith and Dasan, providing the benefit of authorized access to media from a vending machine.

In regard to dependent Claims 22 and 23, Claims 22 and 23 reflect the method of creating a hardcopy media selection made by a user as claimed in Claim 21, and is rejected along the same rationale.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith. In regard to dependent Claim 11, Smith does not specifically teach *a user interface with a touch screen display*. However, Smith does teach that the customer can enter the requested news item via the keyboard (8) and the cost of the purchase is displayed on the display (6) (Col. 2, lines 15-17). It therefore would have been obvious to one of ordinary skill in the art at the time of invention to use a touch screen in place of the combination of a keyboard and a display, providing the benefit of an integrated entry and display, leaving more room for other features.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Blackwell whose telephone number is 703-305-0940. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 703-305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James H. Blackwell
06/09/04


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER